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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Brian D. Ryder

Serial No.: 09/938,784

Filed: August 24, 2001

For: ADDITION OF MOUSE ZOOM AND
HOT-KEY FUNCTIONALITY TO
BIOMETRIC SECURITY
FINGERPRINT READERS IN
NOTEBOOK COMPUTERS

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Group Art Unit: 2672

Examiner: Chung, Daniel J.

Atty. Docket: COMP:0235/FLE/VYA
200302010-1

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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March 7, 2005

Date

Manish Vyas

Dear Sir:

**SUMMARY OF INTERVIEW WITH PRIMARY EXAMINER AND
REQUEST FOR INTERVIEW WITH SUPERVISORY PRIMARY EXAMINER**

The Examiner issued a Final Official Action on November 16, 2004. In the Response to the Final Official Action mailed by Applicant on January 18, 2005, Applicant attempted to demonstrate to the Examiner that the proper interpretation of certain language of the pending claims distinguished the claimed subject matter from the cited art. After considering Applicant's arguments, the Examiner found them to be non-persuasive as discussed in the Advisory Action mailed on February 8, 2005. Specifically, the Examiner stated:

Applicant's arguments filed 1-24-2005 are not persuasive. Specifically, Applicant argued that the cited reference does not disclose a device or component having both zoom functionality and hot-key functionality. However it is noted that the features upon which Applicant relies (i.e., both zoom functionality and hot-key functionality) are not recited in

the rejected claim(s). See *In re Van Geuns*, 988 F. 2d 1181, 26 USPQ2d 1057 (Fed. Circ. 1993). In fact, the recited claim merely states "...the fingerprint scanner to perform a function (emphasis added), ...at least one of a zoom function and a hot-key function", where "a function" refer to either a zoom function or a hot-key function. Further, in response to the Applicant's argument regarding to 69 U.S.P.Q. 2d 1865, 1876, (i.e., the list is conjunctive because the term "a desired" is repeated for each category and the final category in the criteria list is introduced by "and a desired"), Examiner asserts that such interpretation is not applicable into presented application, because such term [e.g., desired], does not exist in the presented application. Furthermore, in this case, there is no way that "at least one of" refers only to one category of the criteria would contradict the purpose of the invention as described in the written description. Even if, the recited claim indicates the meaning of a zoom function and a hot-key function together within a function, there is no indication in the written description of presented application that fingerprint scanner performs both zoom function and hot-key function at same time. In fact, Examiner asserts that it is impossible to operate two different functions [i.e., zoom, hot-key] simultaneously with a single device by performing a single function, as claimed. Dependent claims are also rejected by dependency.

In other words, the Examiner (1) does not believe that the claims recite a method or device that performs both a zoom function and a hot-key function; (2) believes that if the present claims are interpreted as suggested by Applicant that it would require the fingerprint scanner to perform both the zoom function and the hot-key function simultaneously; and (3) does not believe that the *SuperGuide* case cited by Applicant applies to the present claims.

In view of the Examiner's positions set forth in the Advisory Action, the undersigned contacted Examiner Chung to perform a brief telephonic interview on March 3, 2005. During this interview, the undersigned attempted to explain to the Examiner the manner in which it is believed that the Examiner has misconstrued the present claims and misinterpreted the *SuperGuide* case. At the conclusion of the interview, the undersigned proposed transmitting an Interview Summary and/or a proposed amendment to the Examiner to set forth these

explanations in writing for further consideration by Examiner Chung and by the Supervisory Primary Examiner. Accordingly, these explanations are set forth in detail below, and Applicant respectfully requests a follow-up telephonic interview with the Examiner and the Supervisory Primary Examiner prior to the four-month deadline which expires on March 16, 2005, if possible.

Prior to discussing each of the three issues raised by the Examiner, it is important to look first to the *SuperGuide* case relied upon by Applicant in the Response to the Final Official Action. In *SuperGuide Corp. v. DirecTV Enterprises Inc.*, 69 U.S.P.Q.2d 1865, 1876 (Fed. Cir. 2004), a copy of which is attached for the Examiner's convenience, one of the claims at issue recited "at least one of a desired program start time, a desired program end time, a desired program service, and a desired program type" and "at least one of program start time, program end time, program service, and program type." *Id.* at 1876. Accordingly, both the district court and the Federal Circuit were tasked with determining the meaning of a phrase that is structured to read "at least one of a, b, c, and d." *See id.* The district court construed the phrase "at least one of...and..." as meaning at least one of *each* criterion, *i.e.*, a minimum of one of *each* category. *Id.* On appeal, SuperGuide contended that the phrase "at least one of" required "*one or more* of the four listed criteria." (Emphasis in original). SuperGuide argued that the use of the term "and" rather than "or" was dictated by the then existing PTO rules that suggested that the use of alternative expressions such as "or" might make a claim indefinite. *See id.* at 1876-1877. Direct TV countered that the district court's construction is supported by the use of the conjunctive word "and" and by the grammatical rule requiring that the phrase "at least one of" be applied to each category in the list. *Id.* at 1876.

The Federal Circuit agreed with the district court and Direct TV. *Id.* at 1877. The Federal Circuit held that the phrase “at least one of” means “one or more.” *Id.* The Federal Circuit further held that when the phrase “at least one of” proceeds a series of criteria, and the patentee uses the term “and” to separate the criteria, the phrase “at least one of” modifies *each* member of the conjunctive list. *Id.* In other words, a claim containing the phrase “at least one of a, b, and c” must be interpreted to require “at least one of a, at least one of b, *and* at least one of c,” and not, as suggested by SuperGuide, “a, b, or c, or any combination thereof.”

In the present application, and as discussed fully in Applicant’s response to the Final Official Action, the present claims each contain the phrase “at least one of” followed by a conjunctive list. For example, claim 1 recites “a function, wherein the function comprises at least one of a zoom function and a hot-key function.” Independent claim 17 recites “configuring a computer to perform at least one of a zoom function and a hot-key function.” Independent claim 22 recites “providing software that configures the processor to interpret signals from the fingerprint scanner as at least one of a zoom function and a hot-key function.” Finally, independent claim 26 recites “means for configuring a computer to perform at least one of a zoom function and a hot-key function.” Given the phraseology used in the present claims, it is clear that the interpretation of the Federal Circuit in the *SuperGuide* case is relevant to the interpretation of the present claims.

Following the claim interpretation rules set forth by the Federal Circuit in the *SuperGuide* case, the phrase “at least one of a zoom function and a hot-key function,” as used in each of the present claims, must be construed to mean that the claimed method or apparatus performs at least one zoom function *and* at least one hot-key function. Given this

interpretation, Applicant will now address the three issues raised by the Examiner in the Advisory Action.

In regard to the Examiner's first issue, *i.e.*, the Examiner's allegation that the claims recite a single function that may either be a zoom function *or* a hot-key function, Applicant trusts that the discussion set forth above addresses the bulk of this issue sufficiently. In particular, the phrase "at least one of a zoom function and a hot-key function" cannot be interpreted as an alternative expression as alleged by the Examiner. Rather, it must be interpreted as a conjunctive expression that requires *both* the zoom function and the hot-key function. Thus, the only issue remaining revolves around whether the use of the phrase "a function" alters this meaning in some fashion. First, Applicant wishes to note that the term "a function" is only used in independent claim 1, and it is not used in independent claims 17, 22, and 26. Accordingly, the Examiner's allegation is not relevant to independent claims 17, 22, and 26, nor any claims dependent thereon. Consequently, independent claims 17, 22, and 26, as well as all claims dependent thereon, must be interpreted as discussed above.

In regard to independent claim 1, Applicant respectfully submits that the use of the term "a function" does not alter the meaning of the phrase "at least one of a zoom function and a hot-key function." However, the reasoning behind Applicant's belief in this regard is best expressed with reference to the second issue, *i.e.*, the Examiner's allegation that even if the claim indicates that a zoom function and a hot-key function may be performed, there is no indication that these functions can be performed at the same time. In regard to this issue, Applicant respectfully submits that none of the claims contain any recitation that requires that the zoom function and the hot-key function be performed at the same time. Applicant's specification discloses that the fingerprint reader 212 may be configured to perform a security

function while simultaneously generating position and velocity vectors for other functions.

Page 12, lines 11-15. The specification also discloses that the fingerprint reader can be configured to function as a scrolling/zoom device, a hot-key device, *and* a function select device. Page 17, lines 4-7. The specification further discloses that the fingerprint reader can be configured to perform a security function simultaneously with any of the scroll, zoom, *and* hot-key functions. Page 17, line 22, to page 18, line 1. Accordingly, the specification clearly refutes the Examiner's position. In other words, the specification states that the security function may be performed simultaneously with other functions, such as the zoom function and the hot-key function, and the specification further states that the fingerprint scanner can be programmed to perform *both the zoom function and the hot-key function*, although not simultaneously with one another. Given this context, it is clear that the language of claim 1 is clearly definite and accurately written to define the manner in which the claimed fingerprint scanner is enabled. Specifically, claim 1 recites that the fingerprint scanner is enabled to perform "a function, wherein the function comprises at least one of a zoom function and a hot-key function." In other words, the fingerprint scanner can perform at least one zoom function and at least one hot-key function, and nothing in the claim requires that the fingerprint scanner has to perform these different functions simultaneously. Therefore, claim 1 is fully supported by the specification, and there is nothing in the specification or in claim 1 that would require these two functions to be performed simultaneously as alleged by the Examiner.

Finally, the Examiner alleged that the interpretation set forth in the *SuperGuide* case is not applicable to the present application because the term "desired" is not repeated for each category in the conjunctive list. Applicant respectfully submits that the Examiner has clearly misinterpreted the holding in the *SuperGuide* case. While it is true that the claims at issue in

the *SuperGuide* case included the term “desired” before certain categories in a conjunctive list, neither the term “desired” nor the type of categories in the conjunctive list played any role whatsoever in the district court’s or the Federal Circuit’s interpretation of the claims. Indeed, just the contrary is true, as discussed at length above, and as discussed at length on pages 1876 and 1877 of the *SuperGuide* opinion. Both the district court and the Federal Circuit focused on the proper construction of the phrase “at least one of...and.” In other words, the court focused solely on the meaning of the phrase “at least one of” when used as preceding a conjunctive list such as “a, b, c, and d.” Whether the term “desired” is used in the conjunctive list is of no moment whatsoever.

In view of the arguments set forth above, Applicant respectfully requests reconsideration of the above-referenced application. Specifically, Applicant respectfully submits that the Examiner has misinterpreted the present claim language in view of the *SuperGuide* case, and Applicant respectfully submits that the claims, as properly construed, are allowable over the prior art of record. Accordingly, Applicant respectfully requests withdrawal of the Examiner’s rejection and allowance of all pending claims.

Furthermore, although Applicant fully realizes that neither the Examiner nor the Supervisory Primary Examiner is obligated to grant another telephonic interview, Applicant is merely trying to advance prosecution of the present application and expedite allowance of the present claims. Accordingly, Applicant respectfully requests that the Examiner and the Supervisory Primary Examiner grant another telephonic interview, if necessary, to address any questions the Examiner may have regarding the above arguments. Preferably, Applicant requests that such interview be granted prior to the four-month deadline of March 16, 2005.

The interview may be initiated through the undersigned or through another attorney of record,
Manish Vyas, at the telephone number listed below.

Respectfully submitted,

Date: March 7, 2005



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